IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

10-28-02

In re application of:
Buschmann *et al.*
Appl. No. 09/805,432
Filed: March 14, 2001
For: **Means and Methods for the Modulation of Arteriogenesis**

Confirmation No. 3195
Art Unit: 1635
Examiner: Angell, J. Eric
Atty. Docket: 0780.0210000/JAG/JSO

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **September 23, 2002**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group II, represented by claims 1, 3, 4, 6, and 8-12.

During a telephone discussion on October 23, 2002, Examiner Angell clarified that the election of Group II would include a method for enhancing arteriogenesis comprising contacting organs, tissue, or cells with a TGFβ1 protein.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should this requirement be made final. In such case, Applicants retain the right to petition from this Restriction Requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

The Restriction Requirement

The Examiner has restricted the claims into seventeen different groups. According to the Restriction Requirement, Groups I to VIII, claims 1, 3, 4, 6, and 8-12, are directed to a method for enhancing arteriogenesis comprising contacting organs, tissue or cells with TGFβ1, wherein TGFβ1 is a derivative or a functionally equivalent substance that is an antibody (Group I), a (poly)peptide (Group II), a nucleic acid encoding TGFβ1 (Group III), a small organic compound (Group IV), a ligand (Group V), a hormone (Group VI), a PNA (Group VII), and a peptidomimetic (Group VIII).

Also according to the Restriction Requirement, Groups IX-XVI, claims 13 and 15-20, are directed to a method for the treatment of tumors comprising contacting an organ, tissues or cells with an agent which suppresses arteriogenesis, the agent derived from an antibody (Group IX), a (poly)peptide (Group X), a nucleic acid (Group XI), a small organic compound (Group XIIV), a ligand (Group XIII), a hormone (Group XIV), a PNA (Group XV), and a peptidomimetic (Group XVI).

The Examiner also restricted the claimed invention to Group XVII, claims 22 and 23, as being drawn to a method for enhancing arteriogenesis comprising *ex vivo* treatment.

The Search and Examination of the Groups Can Be Made Without Serious Burden

Applicants point out that MPEP § 803 states, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Here, it would not be a serious burden for the Examiner to search and examine all of the pending claims together, or at least the inventions of Groups I-VIII and XVII.

For example, the fields of search for all seventeen of the groups are highly overlapping. Illustratively, most of the Groups are classified in class 514. Thus, it would not be a serious burden to search the related subclasses in which the separate Groups have been classified.

Additionally, Groups I-VIII and XVII are all directed to methods for enhancing arteriogenesis and/or the growth of collateral arteries and/or other arteries from preexisting arteriolar connections. As a result, it would not be a serious burden for the Examiner to search the derivatives or functionally equivalent substances embodied in Groups I-VIII, as well as a nucleic acid molecule embodied in Group XVII in connection with such methods.

Additional Comments

Separately, Applicants note that in paragraph 3 of the Restriction Requirement, page 5, it states that each of the inventions of Group IX-XVI are unrelated because each is drawn to the *ex vivo* administration of a chemically distinct compound. Applicants wish to point out that none of claims 13 and 15-20 are limited to *ex vivo* administration.

Reconsideration and withdrawal of the Restriction Requirement is respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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